

REMARKS

This is in response to the Office Action mailed on January 6, 2006, in which an election was required of a single disclosed species for prosecution between Species A (FIG. 5b) and Species B (FIG. 5c); claims 1, 6, 7, 13, 17-19, and 24 were rejected under 35 U.S.C. § 102(a) as being anticipated by Priebe et al. (U.S. Pat. App. Pub. 2003/0075566); claims 17-19 and 24 were rejected under 35 U.S.C. § 102(b) as being anticipated by Osgar (U.S. Pat. No. 5,526,956); claims 1, 2, 4-7, 14, 16-20, and 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Qutub (U.S. Pat. No. 5,601,066) in view of Zoder (U.S. Pat. No. 2,240,277); claims 8-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Priebe et al. in view of Osgar et al. (U.S. Pat. No. 5,875,921); and claims 1 and 13 were provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 8 of copending Application No. 10/247,107 in view of Osgar '921. With this Amendment, claims 1-7, 9-12, 17, and 20 are amended. Claims 1-24 remain pending in the present application.

Election/Restriction

The Examiner required an election of a single disclosed species for prosecution between Species A (FIG. 5b) and Species B (FIG. 5c). In a telephone conference between Examiner Craig Price and David Fairbairn on December 15, 2005, Species A (FIG. 5B) was elected for prosecution on the merits. However, Applicants wish to shift their election to Species B (FIG. 5c) for prosecution on the merits. This shift is permissible because it would not result in additional work or expense for the Office. MPEP 819.01.

In addition, the election of Species B is made with traverse because the embodiments of Species A and Species B are so related that a search and examination of the entire application can be made without serious burden to the Examiner. MPEP 803. Consequently, the claims directed to Species A and Species B should be examined together.

Claim Rejections - 35 U.S.C. § 102

Priebe et al. (U.S. Pat. App. Pub. 2003/0075566)

Claims 1, 6, 7, 13, 17-19, and 24 were rejected under 35 U.S.C. § 102(a) as being

anticipated by Priebe et al. In order to reject a claim under § 102(a), the reference must teach each and every limitation of the claims. MPEP 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). With this Amendment, claims 1, 6, 7, and 17 are amended. Amended claim 1 recites a liquid dispensing and recirculating system comprising a container, a connector including a probe having a flow passage therein, and a pump coupled with the probe for pumping fluid in the container through the probe. The system also includes “a fluid return channel extending longitudinally along an exterior of the probe for returning recirculated fluid to the fluid in the container such that air in the fluid is released above the fluid in the container to prevent injection of air into the fluid in the container.” Amended claim 17 recites a method of dispensing and recirculating liquids comprising “defining a fluid return channel extending longitudinally along an exterior of the probe,” dispensing fluid from the container through the fluid passage, and refilling fluid into the container through the fluid return channel such that air in the fluid is released above the fluid in the container to prevent injection of air into the fluid in the container.

Priebe et al. teach various embodiments of a re-circulation probe including dispensing vessel 42, opening 46, and integral connector 44. Priebe et al. is directed to re-circulation probes having return flow paths that are concentric with the output flow path. In the embodiment shown in FIG. 6, for example, re-circulation probe 100 is coupled to a liquid-dispensing system 102 via dispensing line 104. The dispensing line 104 is coupled to the output port 106, which in turn is coupled to the output flow path 108 defined by dip tube 110. “Recirculating of the high viscosity liquid is effected via recirculating line 112 to a recirculating port 114, then to an annular return flow path 116 that is concentric to the output flow path 108.” Paragraph 0078. “It is also within the scope of the present invention to use output flow path and return flow path configurations that are not concentric, as long as the output flow area is substantially equal to the return flow area.” Paragraph 0058.

However, Priebe et al. do not teach a return flow path that “extend[s] longitudinally along an exterior” of the dip tube, as is required by claims 1 and 17. Rather, the return flow paths in the various re-circulation probe embodiments of Priebe et al. are contained within the dip tube 110,

such that the return flow path is defined by an outer wall of the dip tube and an outer wall of the output flow path. See, e.g., FIG. 3B, paragraph 0053. In a non-concentric design, "the output flow path can have a semi-circular shaped cross-sectional area, while the return flow path can have a complementary semi circular cross-sectional area of equal or substantially equal size." Paragraph 0077. Therefore, the recited elements of claims 1 and 17 are not disclosed by Priebe et al. and the rejection of claims 1 and 17 under 35 U.S.C. § 102(a) should be withdrawn.

Claims 6, 7, 13, 18, 19, and 24 were also rejected under 35 U.S.C. §102(a) as being anticipated by Priebe et al. Claims 6, 7, and 13 depend from claim 1, and claims 18, 19, and 24 depend from claim 17. As discussed above, claims 1 and 17 are not anticipated or otherwise taught by Priebe et al. Therefore, claims 6, 7, 13, 18, 19, and 24 also are not anticipated or otherwise taught by Priebe et al.

Osgar '956 (U.S. Pat. No. 5,526,956)

Claims 17-19 and 24 were rejected under 35 U.S.C. § 102(b) as being anticipated by Osgar '956. With this Amendment, claim 17 is amended to recite a method of dispensing and recirculating liquids comprising providing a container, coupling a connector to the container including a probe that defines a fluid passage terminating within the interior of the container at a tip of the probe, defining a fluid return channel extending longitudinally along an exterior of the probe, dispensing fluid from the container through the fluid passage, and refilling fluid into the container through the fluid return channel such that air in the fluid is released above the fluid in the container to prevent injection of air into the fluid in the container.

Osgar '956 discloses a liquid chemical dispensing and recirculating system 10 including container 12 and dispenser 14. Dispenser 14 is mounted on container 12 to dispense and recirculate liquid chemicals within container 12. Liquid chemical is withdrawn from container 12 through flow passage 43 of dip tube 26 and flow passage 58 defined by probe 50. After the dispensed liquid chemical is either filtered and/or tested for impurities, dispensed liquid is refilled or recirculated through flow passage 60 within recirculation port 54 and probe 50 and through fluid passage 44 which is circumferentially positioned around fluid passage 43. Col. 5, lines 3-50.

However, Osgar '956 does not teach that fluid passage 44 "extend[s] longitudinally along an exterior" of dip tube 26, as is required by claim 17. Therefore, the recited elements of claim 17 are not disclosed by Osgar '956 and the rejection of claim 17 under 35 U.S.C. § 102(b) should be withdrawn.

Claims 18, 19, and 24 were also rejected under 35 U.S.C. §102(b) as being anticipated by Osgar '956. Claims 18, 19, and 24 depend from claim 17. As discussed above, claim 17 is not anticipated or otherwise taught by Osgar '956. Therefore, claims 18, 19, and 24 also are not anticipated or otherwise taught by Osgar '956.

Claim Rejections - 35 U.S.C. § 103

Claims 1, 2, 4-7, 14, 16-20, and 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Qutub in view of Zoder. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP 2143.03; *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). With this Amendment, claims 1, 2, 4-7, 17, and 20 are amended. Amended claim 1 requires a liquid dispensing and recirculating system comprising a container, a connector including a probe having a flow passage therein, and a pump coupled with the probe for pumping fluid in the container through the probe. The system also includes "a fluid return channel extending longitudinally along an exterior of the probe for returning recirculated fluid to the fluid in the container such that air in the fluid is released above the fluid in the container to prevent injection of air into the fluid in the container." Claim 14 as originally submitted recites a probe for dispensing liquid from and returning liquid to a container comprising a flow passage, a fluid return port, and a fluid return channel in fluid communication with the fluid return port via a bore, the fluid return channel extending longitudinally along an exterior of the probe. Amended claim 17 recites a method of dispensing and recirculating liquids comprising defining a fluid return channel extending longitudinally along an exterior of the probe, dispensing fluid from the container through the fluid passage, and refilling fluid into the container through the fluid return channel such that air in the fluid is released above the fluid in the container to prevent injection of air into the fluid in the container.

Qutub discloses a fuel system having a fuel warming subsystem including fuel warming conduit 42 connected to the fuel warming return inlet 40 to act as a heat exchanger. Fuel warming conduit 42 is a relatively large diameter straight tube that surrounds the substantial length of the straight, relatively small diameter suction tube 38. Fuel warming conduit 42 defines a warm fuel return path 43 between the suction tube 38 and the fuel warming conduit 42. Col. 5, lines 55-60.

In other words, warm fuel return path 43 is fully contained within the interior of fuel warming conduit 42. Thus, Qutub does teach or suggest a fluid return channel extending longitudinally along an exterior of the probe as recited in claims 1 and 14, or defining a fluid return channel extending longitudinally along an exterior of the probe as required by the method of claim 17. Zoder does not supply this deficiency in Qutub because Zoder does not teach or suggest a recirculation path. Therefore, since the combination of Qutub and Zoder does not teach or suggest all of the recited elements of claims 1, 14, and 17, the rejection of claims 1, 14, and 17 under 35 U.S.C. § 103(a) should be withdrawn.

Claims 2, 4-7, 16, 18-20, and 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Qutub in view of Zoder, and claims 8-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Priebe et al. in view of Osgar '921. As discussed above, claims 1, 14, and 17 are now in a condition for allowance. Claims 2 and 4-12 depend from allowable claim 1, claim 16 depends from allowable claim 14, and claims 18-20 and 22-24 depend from allowable claim 17. These claims are also allowable, since any claim depending from a patentable independent claim is also patentable. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Double Patenting

Claims 1 and 13 were provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 8 of copending Application No. 10/247,107 in view of Osgar '921. With this Amendment, independent claim 1 has been amended to recite that the fluid return channel extends longitudinally along an exterior of the probe for returning recirculated fluid to the fluid in the container. The claims currently pending are not merely obvious variations of claims 1 and 8 of copending Application No. 10/247,107 in view of

Osgar '921, and the double patenting rejection on this basis should accordingly be withdrawn.

Withdrawn Claims

Claims 3, 15, and 21 were previously withdrawn from consideration as being drawn to a non-elected species. Claim 3 depends from allowable independent claim 1, claim 15 depends from allowable claim 14, and claim 21 depends from allowable claim 17. Thus, claim 3, 15, and 21 should also be considered and allowed, since they depend from an allowable generic independent claim. See MPEP 809.02 and 37 C.F.R. 1.146.

CONCLUSION

In view of the foregoing, it is believed that all claims in the present application are in condition for allowance. Reconsideration and allowance of claims 1, 2, 4-14, 16-20, and 22-24 are respectfully requested. In addition, claims 3, 15, and 21 should also be considered and allowed, since they depend from allowable generic independent claim 11. A Notice of Allowance with respect to all claims 1-24 is respectfully requested.

Respectfully submitted,

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